

PRELIMINARY REMARKSRECEIVED
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Claims 21 to 38 are now pending in this case, Claims 1 to 20 have been canceled, as indicated in the Listing of Claims set forth in Appendix I of this paper.

New Claim 21 corresponds to Claim 1 with the features of Claims 2 and 5 being included, the abrasive being further specified in accordance with the disclosure on page 4, indicated lines 7 to 13, the surfactant being further specified in accordance with the disclosure on page 5, indicated lines 12 to 22, the inert carrier being further specified in accordance with the disclosure on page 6, indicated line 13, and the basis for the weight percentages being further specified in accordance with applicants' disclosure in Table 1 on page 8 of the application.

New Claims 22 and 23 further specify the agent inhibiting film-formation in accordance with the disclosure on page 6, indicated lines 29 to 31, and indicated lines 21 to 22, of the application.

New Claim 24 corresponds to Claim 6, and new Claims 25 and 26 further specify the abrasive in accordance with applicants' disclosure on page 4, indicated lines 8 and 13, respectively. New Claim 27 further specifies the surfactant in accordance with the disclosure on page 5, indicated line 17, of the application.

New Claim 28 corresponds to Claim 21 with the insecticide being further specified in accordance with the disclosure on page 4, indicated line 4, the surfactant being further specified in accordance with the disclosure on page 5, indicated line 17, and the inert carrier being further specified in accordance with the disclosure on page 6, indicated lines 13 and 14, of the application.

New Claim 31 corresponds to Claim 21 with the insecticide being further specified in accordance with the disclosure on page 4, indicated line 4, the surfactant being further specified in accordance with the disclosure on page 5, indicated line 17, the inert carrier being further specified in accordance with the disclosure on page 6, indicated lines 13 and 14, and the agent inhibiting film-formation being further specified in accordance with the disclosure on page 6, indicated lines 29 to 31, of the application.

New Claim 33 corresponds to Claim 21 with the insecticide being further specified in accordance with the disclosure on page 4, indi-

cated line 4, the surfactant being further specified in accordance with the disclosure on page 5, indicated line 17, the abrasive being further specified in accordance with applicants' disclosure on page 4, indicated line 8, the surfactant being further specified in accordance with the disclosure on page 5, indicated line 17, the inert carrier being further specified in accordance with the disclosure on page 6, indicated lines 13 and 14, and the agent inhibiting film-formation being further specified in accordance with the disclosure on page 6, indicated lines 23 and 29 to 31, of the application.

New Claims 29, 32, 35 and 37 depend upon Claims 28, 31, 34 and 21, respectively, and further specify the insecticide in accordance with applicants' disclosure on page 3, indicated lines 29 to 31, and new Claims 30, 33, 36 and 38 depend upon Claims 29, 32, 35 and 37, respectively, and correspond to Claim 7.

No new matter has been added.

The Examiner rejected Claims 1 to 20 under 35 U.S.C. §112, ¶2, for failing to recite the basis for the weight percentages. The respective argument is not applicable to the claims herewith submitted since Claim 21 recites the basis and Claims 22 to 38 incorporate the definitions provided in Claim 21 by reference. Withdrawal of the respective rejection is therefore solicited.

The Examiner rejected Claims 16 to 20 under 35 U.S.C. §112, ¶1. Withdrawal of the respective rejection is solicited in light of applicants' cancellation of those claims.

The Examiner rejected Claims 1 to 14 and 16 to 20 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Putter et al.* (US 4,678,774) when taken in view of the teachings of *Knight et al.* (WO 94/27434), *Lovell* (US 5,187,184) and *Schaaf et al.* (EP 821 876). The Examiner's argument in this regard is, inter alia, based on the assertion that *Putter et al.* disclose an insecticidal composition comprising an abrasive, silicon dioxide.

It is respectfully submitted that the silicon dioxide component of the composition disclosed by *Putter et al.* is not an abrasive. *Putter et al.* state that

highly dispersed, hydrophyllic amorphous silicon dioxide which is

useful in this invention is available from various manufacturers such as the various forms of Aerosil® available from Degussa Corporation. The highly dispersed, amorphous silicon dioxide is of a high surface area ranging from 35 to 400 m² per gram and an average particle size of about 7 to 40 nanometers,

(col. 2, indicated lines 5 to 12, of US 4,678,774). Applicants herewith enclose a copy of *Ullmann's Encyclopedia of Industrial Chemistry*¹⁾ which addresses the morphology of Aerosil® which is mentioned by *Putter et al.* in the foregoing section, and of Cab-o-Sil, another product mentioned by *Putter et al.* in col. 2, indicated lines 14 and 15, of US 4,678,774²⁾. Accordingly, those products are "extremely fine, mostly spherical particles with diameters of ca. 10 nm"³⁾. Additionally, *Ullmann* states⁴⁾

X-ray diffraction photographs with a detection limit of 0.2% for Aerosil 200, a hydrophyllic pyrogenic silica with a specific surface area of ca. 200 m²/g, show no crystallinity ...

In light of *Ullmann's* background information on the silicon dioxides which are employed by *Putter et al.*, those silicon dioxides lack abrasive properties because of their lack of crystallinity and due to the mostly spherical form of their particles. A person of ordinary skill in the art would therefore not have been motivated to modify the teaching of *Putter et al.* by replacing the silicon dioxide which has "extremely fine, mostly spherical particles" and exhibits "no crystallinity" by abrasives as taught by *Knight et al.* The disclosures of *Lovell* and of *Schaaf et al.* merely to show that arylpyrroles are known insecticides.

Moreover, applicants' invention as defined in the claims herewith presented requires the presence of an abrasive selected from the group consisting of alkali metal silicates and alkaline earth metal silicates. Neither one of the references applied by the Examiner provides for the utilization of such abrasives, or the application of such abrasives in amount of from 3 to 9% by weight in a non-aqueous sprayable insecticidal composition. In accordance with the teaching of *Knight et al.*, the abrasives are crystalline alkaline metal car-

1) Vol. A23, 5th Edition, VCH Verlagsgesellschaft mbH, Weinheim 1993, pages 635-639; in the following referred to as "*Ullmann*".

2) Note *Ullmann*, page 635, last para. of Section 6.1. "Flame Hydrolysis".

3) Note *Ullmann*, page 636, first para. of Section 6.1.2. "Morphology" and Figure 6.4. on page 637.

4) Note *Ullmann*, page 637, first para. of Section 6.1.3. "Solid-State Properties"

bonates, alkaline metal bicarbonates and alkaline earth metal carbonates⁵).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success, and, finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and cannot be based on applicant's disclosure⁶). Also, the level of skill in the art cannot be relied upon to provide the suggestion to combine references⁷). Accordingly, the mere fact that the prior art can be modified in some manner so as to arrive at a claimed invention does not support a conclusion of obviousness unless the prior art suggests the desirability of the specific modification which is required⁸).

In light of the foregoing, the teaching of *Putter et al.* when taken in view of the teachings of *Knight et al.*, *Lovell* and *Schaaf et al.* does not meet the three basic criteria for a prima facie case of obviousness where applicants' Claims 21 to 38 are concerned. Favorable action is respectfully solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a five month extension of time be granted in this case. A check for the \$2,010.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit

5) Note, for example, Claims 2 and 3 on page 19, as well as page 2, indicated line 33 et seq., and page 5, indicated line 30 et seq., of *WO 94/27434*.

6) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (CAFC 1991)

7) *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161, 1171 (CAFC 1999)

8) ie. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984); see also, eg., *Interconnect. Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985)

Serial No. 09/282,857

KIMLER et al.

ACY 33432-01

Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Encl.: THE LISTING OF CLAIMS (Appendix I)

Ullmann's Encyclopedia of Industrial Chemistry, Vol. A23, 5th Edition,
VCH Verlagsgesellschaft mbH, Weinheim 1993, pages 635-639

HBK/BAS

A P P E N D I X I:

THE LISTING OF CLAIMS (version with markings):

1. (canceled)
2. (canceled)
3. (canceled)
4. (canceled)
5. (canceled)
6. (canceled)
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15. (canceled)
16. (canceled)
17. (canceled)
18. (canceled)
19. (canceled)
20. (canceled)
21. (new) A non-aqueous sprayable insecticidal composition which comprises
from 10 to 70% by weight of at least one insecticide;
from about 3% to about 9% by weight of an abrasive selected from
the group consisting of alkali metal silicates and alkaline earth
metal silicates;

- from about 2% to about 15% by weight of a surfactant;
from 25 to 75% by weight of a solid inert carrier; and
optionally an effective amount of an agent to inhibit the formation of a film,
wherein the weight percentages are based on the total weight of the non-aqueous sprayable insecticidal composition.
22. (new) The composition defined in claim 21, wherein the agent to inhibit the formation of a film is present in from 1 to 6% by weight of the composition.
23. (new) The composition defined in claim 21, wherein the agent to inhibit the formation of a film is an alkali metal halide or an alkaline earth metal halide.
24. (new) The composition defined in claim 21, wherein the inert carrier is kaolin clay.
25. (new) The composition defined in claim 21, wherein the abrasive is calcium silicate.
26. (new) The composition defined in claim 25, wherein the calcium silicate is present in from 5 to 7% by weight of the composition.
27. (new) The composition defined in claim 21, wherein the surfactant is present in from 2 to 7% by weight of the composition.
28. (new) The composition defined in claim 21, which comprises
from 10 to 30% by weight of the at least one insecticide;
from about 2% to about 7% by weight of the surfactant; and
from 55 to 75% by weight of the solid inert carrier.
29. (new) The composition defined in claim 28, wherein the insecticide is selected from insecticides effective against crawling insect pests.
30. (new) The composition defined in claim 29, wherein the crawling insect pests are selected from the group consisting of cockroaches, ants, crickets, silverfish, earwigs, flour beetles, termites and wood-boring beetles.
31. (new) The composition defined in claim 21, which comprises
from 10 to 30% by weight of the at least one insecticide;
from about 2% to about 7% by weight of the surfactant;

from 55 to 75% by weight of the solid inert carrier; and
from 1 to 6% by weight of the agent to inhibit the formation of a
film.

32. (new) The composition defined in claim 31, wherein the insecticide is selected from insecticides effective against crawling insect pests.
33. (new) The composition defined in claim 32, wherein the crawling insect pests are selected from the group consisting of cockroaches, ants, crickets, silverfish, earwigs, flour beetles, termites and wood-boring beetles.
34. (new) The composition defined in claim 21, which comprises
from 10 to 30% by weight of the at least one insecticide;
from about 3% to about 9% by weight of calcium silicate;
from about 2% to about 7% by weight of the surfactant;
from 55 to 75% by weight of kaolin clay; and
from 1 to 6% by weight of calcium chloride.
35. (new) The composition defined in claim 34, wherein the insecticide is selected from insecticides effective against crawling insect pests.
36. (new) The composition defined in claim 35, wherein the crawling insect pests are selected from the group consisting of cockroaches, ants, crickets, silverfish, earwigs, flour beetles, termites and wood-boring beetles.
37. (new) The composition defined in claim 21, wherein the insecticide is selected from insecticides effective against crawling insect pests.
38. (new) The composition defined in claim 21, wherein the crawling insect pests are selected from the group consisting of cockroaches, ants, crickets, silverfish, earwigs, flour beetles, termites and wood-boring beetles.